



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

SC

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/899,454	07/05/2001	Gerald Francis McBrearty	AUS9-2001-0344-US1	4098
7590	08/15/2005		EXAMINER	
Volel Emile International Business Machines Corporation Intellectual Property Law Department 11400 Burnet Road, Internal Zip 4054 Austin, TX 78758			STORK, KYLE R	
			ART UNIT	PAPER NUMBER
			2178	
			DATE MAILED: 08/15/2005	

Please find below and/or attached an Office communication concerning this application or proceeding.

MAILED

AUG 15 2005

Technology Center 2100



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/899,454

Filing Date: July 05, 2001

Appellant(s): MCBREARTY ET AL.

International Business Machines Corporation
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 20 May 2005.

(1) Real Party in Interest

Application/Control Number: 09/899,454

Art Unit: 2178

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 1-36 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

Application/Control Number: 09/899,454

Art Unit: 2178

2002/0016786	Pitkow et al.	2-2002
6032162	Burke	2-2000

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-36 rejected under 35 U.S.C. 103. This rejection is set forth in a prior Office Action, mailed on 12 January 2005.

(11) *Response to Argument*

The applicant argues that Ryan fails to “suggest the claimed invention or even a system or process which suggest that it would be modifiable (page 4). However, the Examiner respectfully disagrees. As the applicant acknowledges, Ryan teaches “an algorithm which does deal with Web source or site transmission activity or hit rates (page 5).” The applicant is correct in arguing that the algorithm in Ryan applies specifically to search engine activity. However, the applicant ignores Ryan’s teaching of a “Personal hit-list” in column 7, lines 37-40. Here, Ryan discloses the “Personal hit-list,” as “a list of web-pages the individual user has found most useful for each key-word search they have done in the past. It is like an automatic book-marking data set for each individual user (column 7, lines 37-40).” Here, Ryan suggests book-marking search results based upon usefulness to a user. Ryan further discloses combining several input data sets to generate a collective search hit-list (column 7, lines 54-62). This collective search hit-list contains data from both the “High-flyers hit list” which makes use of transmission activity and hit rates as well as the “Personal hit-list,” comprised of bookmarked data sets.

Application/Control Number: 09/899,454

Art Unit: 2178

Ryan therefore suggest the combination of a bookmarked data sets with hit rate data, in order to present a user a "ranked hit-list of Web-pages... after the keyword search" (column 7, lines 54-62).

Further, Pitkow discloses the use of bookmarking web documents received at a web station. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Ryan's method with Pitkow's method, since it would have allowed a user the benefit of bookmarking useful search results (Ryan: column 7, lines 37-40; Pitkow: paragraph 0136).

The applicant further argues that the combination of Ryan and Pitkow fail to disclose displaying activity rates in association with a list of bookmarked documents (page 6). However, the examiner respectfully disagrees. As stated above, Ryan discloses a "Collective Search hit-lists" feature, displaying activity rates associated with the "High-flyers hit-list" in conjunction with the "Personal hit-list" making use of bookmarks (column 7, lines 15-62).

The applicant further argues that "carrying out ... functions in search engines is completely different from carrying out such functions by the Web browser (page 7)." However, the Examiner respectfully disagrees. The applicant discloses merely, "Web browsing means at said receiving display station (claim 9, lines 3-4)." This does not exclude the use of a search engine, accessed through a browser, from performing the method. Ryan similarly discloses use of a web browser (Abstract).

Conclusion

For the above reasons, it is believed that the rejections should be sustained.

Application/Control Number: 09/899,454

Art Unit: 2178

Respectfully submitted,

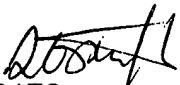
Kyle Stork
Patent Examiner
Art Unit 2178

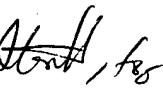


krs

August 3, 2005

Conferees

Steve Hong 
SPE Art Unit 2178

Heather Herndon 
SPE Art Unit 2176



CESAR PAULA
PRIMARY EXAMINER

Volel Emile
International Business Machines Corporation
Intellectual Property Law Department
11400 Burnet Road, Internal Zip 4054
Austin, TX 78758